

REMARKS

In this response, Applicant has not added, canceled or amended any claims. Thus, Claims 2-5, 7, 10 and 16 remain pending.

Rejection of Claims 2, 5 and 16 Under 35 U.S.C. §103(a)

The Examiner has rejected Claims 2, 5 and 16 as unpatentable under 35 U.S.C. § 103(a) over the combination of Nagano, U.S. Patent no. 5,325,735 and Kine, U.S. Patent No. 3,935,930. Reconsideration and withdrawal of the rejection is respectfully requested.

Both Kine and Nagano were asserted previously. Alone or in combination, Kine and Nagano do not disclose or suggest each of the limitations of the rejected claims, and therefore, do not render them obvious.

Each of the rejected claims recites a lever that is operatively connected to a rotating member, which in turn, is operatively connected to the master piston of a master cylinder assembly. Neither Kine nor Nagano disclose or suggest these features.

Nagano is directed to a cable-operated gear shifting mechanism. It includes no disclosure related to hydraulic systems, let alone the claimed device.

Kine is directed to a hydraulic brake system. Kine's device includes a lever 2 pivotally connected to a bracket member 1, and includes "a rod connecting the operating lever 2 with the

piston 3" Kine at 2:44-46. Kine does not disclose or suggest operatively connecting its lever 2 to a rotating member that is operatively connected to piston 3. Thus, the combination of Kine and Nagano does not disclose or suggest the claimed features and does not render Claims, 2, 5 or 16 obvious. See CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003 ("obviousness requires a suggestion of all limitations in a claim") (emphasis added), citing In re Royka, 490 F.2d 981, 985 (CCPA 1974).

Moreover, the Examiner has not identified a motivation or suggestion in the prior art for combining Nagano and Kine in the manner necessary to obtain the claimed invention. "When an obviousness determination is based on multiple prior art references, there must be a showing of some teaching, suggestion, or reason to combine the references." Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (citations omitted). See also In re Stencel, 828 F.2d 751, 755 (Fed. Cir. 1987) ("Nor is obviousness established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made"). Neither reference provides any suggestion as to how to operatively connect the claimed rotating member to a master piston. Therefore, to obtain the claimed invention, the references would have to be selectively modified in a manner that is not suggested by either reference. "The mere fact that the prior art could be modified in the manner proposed by the

Examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification." Ex parte Dussaud, 7 USPQ2d 1818, 1820 (Bd. App. & Int'l 1988); see also In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989)

The Examiner asserts that "the teachings of Kine" show that the use of a master-cylinder assembly instead of a Bowden cable assembly "improves the life of the shifting device." Office Action at 3 (emphasis added). However, Kine makes no mention of shifting devices. Moreover, it makes no reference to cable operated brake devices. It does not disclose or suggest the superiority of hydraulic brake systems to cable-operated brake systems, let alone suggest that a hydraulic gear shifting system is preferable to a cable-operated one.

In light of the foregoing, the Examiner has not established that the prior art would motivate one of ordinary skill in the art to combine Nagano and Kine in the manner necessary to obtain the claimed invention. "The factual inquiry whether to combine references . . . must be based on objective evidence of record." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The Examiner's characterization of Kine is unsupported by the reference itself and does not constitute objective evidence of record. Accordingly, the rejection is improper and should be withdrawn.

Claims 5 and 16 depend from Claim 2 and are allowable for the reasons provided above. In addition, however, they each

recite a master cylinder assembly comprising a master cylinder and an adjuster chamber in which an adjusting piston extends. Kine discloses only a single chamber containing piston 3 and volume adjusting member 5. Thus, it does not disclose or suggest the claimed master cylinder assembly configuration. As mentioned above, Nagano does not even deal with hydraulic systems. Therefore, Claims 5 and 16 recite further patentable features that distinguish the references of record.

Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 3 and 4 as obvious under 35 U.S.C. § 103(a) over the combination of Nagano, Kine, and Kund, U.S. Patent No. 5,178,033 ("Kund"). Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 3 depends from Claim 2 and recites further details concerning the claimed push mechanism and return mechanism. As mentioned in Applicant's response to the previous Office Action, Claim 3 does not recite a rack gear or a pinion gear, and it should not be interpreted as including such limitations.

Claim 4 depends from Claim 3 and recites a pinion gear operatively connected to the rotating member and a rack gear engaged with the pinion gear and operatively connected to the master piston.

Kund is directed to a bicycle gear display. The Examiner relies on Kund for its disclosure of a rack and pinion

assembly in Figure 7. Kund does not compensate for the deficiencies of Nagano and Kine. Thus, for the reasons provided above with respect to Claim 2, the combined references do not disclose or suggest all of the limitations of Claim 3 or Claim 4. As also discussed above, there is no motivation in the prior art for combining Nagano and Kine. Therefore, Nagano, Kine, and Kund do not render Claim 3 or Claim 4 obvious.

Further, Claim 4 recites an operative connection between a pinion gear and the claimed rotating member, as well as a rack gear engaged with the pinion gear and operatively connected to the master piston. However, Kund does not suggest or disclose any means for modifying Nagano and Kine to use a rack and pinion gear having the claimed operative connections to a rotating member and master piston. See Ex parte Dussaud, 7 USPQ2d 1818, 1820 (Bd. App. & Int'l 1988); see also In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

Moreover, the prior art does not suggest combining Kund with Kine and Nagano. According to the Examiner, Kund teaches that using a rack and pinion assembly in place of Nagano's spur gear-crown assembly "improves the precision of the device." Office Action at 3. However, Kund does not discuss spur-crown devices or indicate that they are less precise than rack and pinion assemblies. In addition, Kund does not suggest that rack and pinion assemblies should be used in hydraulic systems. Because the Examiner has not identified a motivation or suggestion in the prior art for modifying the references in the

manner required to obtain the claimed invention, the rejection is improper and should be withdrawn.

Rejection of Claims 7 and 10 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 7 and 10 as obvious under 35 U.S.C. § 103(a) over the combination of Nagano, Kine, and Kund. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 7 recites "a rack gear engaged with the pinion gear and operatively connected to the piston of a master cylinder." For the reasons provided above with respect to Claim 4, the combination of Nagano, Kine, and Kund does not disclose or suggest these features and does not render Claim 7 obvious.

Similarly, Claim 10 recites a neutrally biased control lever that actuates a positioning mechanism having a rotating member. The rotating member is operatively connected to a master cylinder assembly having a primary piston. As discussed above with respect to Claim 2, Nagano does not disclose or suggest connecting a rotating member to a master cylinder assembly or how to do it. Nor do Kine or Kund. Thus, the references do not disclose the modifications necessary to obtain the claimed invention, and the rejection should be withdrawn.

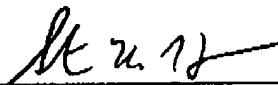
CONCLUSION

Accordingly, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

JEFFER, MANGELS, BUTLER & MARMARO LLP

Dated: September 16, 2005

By: 

Steven R. Hansen, Esq.

Reg. No. 39,214

1900 Avenue of the Stars

Seventh Floor

Los Angeles, CA 90067-4308

(310) 203-8080

Amendment and Response to August
22, 2005 Office Action

-8-

Appl. No. 09/876,346
Atty. Docket No. 57139-5052
Customer No. 24574

3702397v1

PAGE 9/9 * RCVD AT 9/26/2005 8:34:14 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/24 * DNIS:2738300 * CSID: * DURATION (mm:ss):02-26

TOTAL P.09